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EXAMINER

FISCHER, ANDREW J

ART UNIT

PAPER NUMBER

3627

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/657,360

Applicant(s)  
Motohisa Wantanabe

Examiner  
Andrew J. Fischer

Art Unit  
3627



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Mar 6, 2003
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above, claim(s) 5-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some\* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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## **DETAILED ACTION**

### ***Acknowledgments***

1. The amendment filed March 6, 2003 (Paper No. 9) is acknowledged. Accordingly, claims 1-16 remain pending with claims 5-16 withdrawn from consideration as noted below.

### ***Restriction***

2. This application contains claims 9-16 drawn to an invention nonelected with traverse in Paper No. 5. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

### ***Election of Species***

3. This application contains claims 5-16 drawn to a species nonelected with traverse in Paper No. 5. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the Applicant regards as his invention.

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5. Claims 2-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

a. In claims 2 and 3, the phrase “sales item-registering means, when one of entries of correction alternative sales item data is selected for registering the selected entries of correction alternative sales item data” does not make grammatical sense. “A claim must be read in accordance with the precepts of English grammar.” *In re Hyatt*, 708 F.2d 712, 714, 218 USPQ 195, 197 (Fed. Cir. 1983).

b. In claim 3, it is unclear how the “entry of the designated data” effects that displaying of the data “in a different format” since data is data and the format of particular data can be (and usually is) different than other data (e.g. the headings in this Office Action are in bold) while the majority of the language in the body of the Office Action is not in bold even though all the data is textual data).

c. In claims 2 and 3, Applicant has failed to clearly link or associate the corresponding structure from his specification to the function in the 35 U.S.C. 112 6<sup>th</sup> paragraph recitations noted below. “For claim clauses containing functional limitations in ‘means for’ terms pursuant to §112 ¶ 6, the claimed function and its supporting structure in the specification must be presented with sufficient particularity to satisfy the requirements of §112 ¶ 2.” *S3 Inc. v. nVIDIA Corp.*, 259 F.3d 1364, 1367, 59 USPQ2d 1745, 1747 (Fed. Cir. 2001) (citations omitted).

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***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-4, as understood by the Examiner, are rejected under 35 U.S.C. 102(b) as being anticipated by Rapoport et. al. (U.S. 5,262,938) ("Rapoport"). Rapoport discloses a point of sale ("POS") system with the following: a menu (figures 8-23) having a plurality of menu keys (choices listed under 80 "Category") and at least one selection key (choices listed under 82 "Select Item"); a table (inherent in virtually all databases); each of the section keys being used to select one of a sales items assigned to each of the menu keys; a table containing entries of sales item data (description or name, price, and code all inherent); a display device (within 30); a first operation selecting a menu key (from category) is performed, entries of sales item data of all sales items assigned to the selected menu key are retrieved from the table and sales item data (name or description) are displayed on the display device (e.g. figure 8) in such a manner that entry of sales items data of the designated sales item (the particular item the user desires) is distinguished from entries of sales item data of correction alternative sales items (particular items the user does desire); the correction alternative sales items being sale items assigned to the selected menu key (e.g. they are all drinks under the drink category) and the alternative sales items are not the selected (or desired) sales item; wherein a second operation is performed (selecting one of the

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“Select Items” form 82) with the selected entry treated as an entry to be processed; means for searching (by selecting a particular category from 80, viewing the selected items in 82, and then selecting a different category from 80) the table for entries of correction alternative sales item data; display control means (the video controller inherent in any computer); sales items registering means (the enter button); a key table containing the code (virtually all databases have at least one keyed field to prevent redundancy) of sale items (e.g. coffee) and operations (e.g. add coffee to the customer’s tab); a special menu key (the first menu choice in the list of choices, special because its first) and the user searches the keyed table for a sales items code operation (add coffee to the customers tab) and item code (coffee).

8. Claims 1-4, as understood by the Examiner, are rejected under 35 U.S.C. 102(b) as being anticipated by Moderi et. al. (U.S. 5,510,979) (“Moderi”). Moderi discloses a point of sale (“POS”) system with the following: at least one sales item (“COOKIE,” “CAKE,” and “PIE” as shown in Figure 8 are assigned to the “DESSERT” menu key (112) as shown in Figure 7); at least one sales item is assigned to each of the menu keys (in this case, 3 choice are assigned); each of the keys being used to select one of the sales items (inherent);

a table containing entries of sales item data (description or name, price, and code all inherent); a display device (34);

wherein when a first operation is performed including a menu key (selecting the “DESSERT” choice) is performed for a sales item, entries of sales items of all sales items assigned (“COOKIE,” “CAKE,” and “PIE”) are retrieved from the table and all are displayed (as in Figure

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8) in such a manner that the entry of sales items data of the designated sales item (e.g. suppose the operator desires to select PIE, the designated sales item will then be PIE) is distinguished from entries of sales item data of correction alternatives where the correction alternative sale items are sales items which are assigned to the selected menu key (the “DESSERT” key) yet are other than the designated item (other than “PIE, *i.e.* they are “COOKIE” and “CAKE”);

when a second operation is performed, the selected entry is treated as an entry to be processed (inherent since all entries are to be processed);

designated sales item searching means for searching the table for an entry of the designated sale item data (inherent in virtually all databases each for data based upon a query); correction alternative-searching means for searching the table for entries of correction alternative sales item data (inherent in any table look-up procedure); and display controlling means for displaying the entries in a different format (inherent in the operating systems using e.g. different fonts, styles, or layouts).

9. Functional recitation(s) using the word “for” (e.g. “for selecting one of the entries of sales item data of the correction alternative sales items displayed on said display device” as recited in claim 1) have been considered but are given little patentable weight<sup>1</sup> because they fail to add any structural limitations and are thereby regarded as intended use language. A recitation of the intended use of the claimed product must result in a structural difference between the claimed

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<sup>1</sup> See e.g. *In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983)(stating that although all limitations must be considered, not all limitations are entitled to patentable weight.).

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product and the prior art in order to patentably distinguish the claimed product from the prior art. If the prior art structure is capable of performing the intended use, then it reads on the claimed limitation. *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) (“The manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself.”); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). See also MPEP §§ 2114 and 2115. Unless expressly noted otherwise by the Examiner, the claim interpretation principles in this paragraph apply to all examined claims currently pending.

10. The Examiner notes that, “A system is an apparatus.” *Ex parte Fressola* 27 USPQ2d 1608, 1611 (B.P.A.I. 1993)(citations omitted). And “[c]laims in apparatus form conventionally fall into the 35 U.S.C. § 101 statutory category of a ‘machine.’” *Ex parte Donner*, 53 USPQ2d 1699, 1701 (B.P.A.I. 1999)(unpublished), (Paper No. 34, page 5, issued as U.S. Patent 5,999,907). Applicant’s invention is therefore within the ‘machine’ category of §101.

11. The Examiner notes that Applicant has decided not to be his own lexicographer by indicating and defining claim limitations to have meanings other than their ordinary and accustomed meanings. Specifically, after receiving express notice in the previous Office Action<sup>2</sup> of the Examiner’s position that lexicography is *not* invoked, Applicant has not pointed out the “supposed errors” in the Examiner’s position regarding lexicography invocation in accordance with 37 C.F.R. §1.111(b) (i.e. Applicant has not argued lexicography *is* invoked). To further

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<sup>2</sup> See the Examiner’s previous Office Action mailed September 9, 2002, Paper No. 6, Paragraph No. 12.

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support of the Examiner's position that Applicant is not his own lexicographer, it is the Examiner's factual determination that not only has Applicant not pointed to definitional statements in his specification or prosecution history, Applicant has also not pointed to a term or terms in a claim with which to draw in those statements.<sup>3</sup> Finally and to be sure of Applicant's intent, the Examiner also notes that Applicant has declined the Examiner's express invitation<sup>4</sup> to be his own lexicographer.<sup>5</sup> Accordingly and for due process purposes, the Examiner gives notice that for the remainder of the examination process and unless expressly noted otherwise by the Examiner, the heavy presumption in favor of the ordinary and accustomed meaning is not overcome; the claims therefore continue to be interpreted with their "broadest reasonable interpretation . . . ." *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).<sup>6</sup> The Examiner

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<sup>3</sup> "In order to overcome this heavy presumption in favor of the ordinary meaning of claim language, it is clear that a party wishing to use statements in the written description to confine or otherwise affect a patent's scope must, at the very least, point to a term or terms in the claim with which to draw in those statements." *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).

<sup>4</sup> See again the Examiner's previous Office Action Paper No. 6, Paragraph No. 12.

<sup>5</sup> The Examiner's requirements on this matter were reasonable on at least two separate and independent grounds. First, the Examiner's requirements were simply an express request for clarification of how Applicant intend his claims to be interpreted so that lexicography (or even an *attempt* at lexicography) by Applicant was not inadvertently overlooked by the Examiner. Second, the requirements were reasonable in view of the USPTO's goals of compact prosecution, productivity with particular emphasis on reductions in both pendency and cycle time, and other goals as outlined in the USPTO's The 21<sup>st</sup> Century Strategic Plan, February 3, 2003 available at [www.uspto.gov/web/offices/com/strat21/index.htm](http://www.uspto.gov/web/offices/com/strat21/index.htm) (last accessed June 3, 2003).

<sup>6</sup> See also MPEP §2111 and §2111.01; *In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995); *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985) (en

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now relies heavily and extensively on this interpretation.<sup>7</sup> See e.g. *Transclean Corp. v. Bridgewood Servs., Inc.*, 290 F.3d 1364, 1381, 62 USPQ2d 1865, 1877 (Fed. Cir. 2002) (“Because the patentee has not chosen to be his own lexicographer in this instance, [the claimed element] should carry its ordinary meaning . . . .”)(Clevenger, J. dissenting in part). Unless expressly noted otherwise by the Examiner, the preceding claim interpretation principles in this paragraph apply to all examined claims currently pending.

12. Under the broadest reasonable interpretation standard noted above, the Examiner maintains his interpretations. However, to the extent that the Examiner’s interpretations are either different from or in dispute with Applicant’s interpretations, the Examiner hereby adopts the following definitions as the broadest reasonable interpretation in all his claim interpretations:

a. **Server:** “2. On the Internet or other network, a computer or program that responds to commands from a client.” Computer Dictionary, 3rd Edition, Microsoft Press, Redmond, WA, 1997.<sup>8</sup> **Client:** “3. On a local area network or Internet, a computer that accesses shared network resources provided by another computer (called a *server*).” *Id.* **Computer:** “Any

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banc).

<sup>7</sup> See 37 C.F.R. §1.104(c)(3) which states in part: “the examiner may rely upon admissions by applicant . . . as to *any matter* affecting patentability . . . . [Emphasis added.]”

<sup>8</sup> It is the Examiner’s position that the *Microsoft Press Computer Dictionary* is an appropriate technical dictionary known to be used by one of ordinary skill in this art. See e.g. *Altiris Inc. v. Symantec Corp.*, 318 F.3d 1363, 1373, 65 USPQ2d 1865, 1872 (Fed. Cir. 2003) where the Federal Circuit used *Microsoft Press Computer Dictionary* (3d ed.) as “a technical dictionary” used to define the term “flag.”

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machine that does three things: accepts structured input, processes it according to prescribed rules, and produces the results as output.” *Id.*

b. **Data** “Plural of the Latin *datum*, meaning an item of information. In practice, data is often used for the singular as well as plural the form of the noun.” *Id.*

c. **Database** “A file composed of records, each containing fields together with a set of operations for searching, sorting, recombining and other functions.” *Id.*

d. **Format** “1. In general, the structure or appearance of a unit of data.” *Id.*

e. **Menu** “A list of options from which a user can make a selection in order to perform a desired action, such as choosing a command or applying a particular format to part of a document. Many application programs, especially those that offer a graphical user interface, use menus as a means of providing the user with an easily learned, easy-to-use alternative to memorizing program commands and their appropriate use.” *Id.*

f. **Network** “A group of computers and associated network devices that are connected by communications facilities.” *Id.*

g. **Relational Database** “A database or database management system that stores information in tables—rows and columns of data—and conducts searches by using data in specified columns of one table to find additional data in another table. In a relational database, the rows of a table represent records (collections of information about separate items) and the columns represent fields (particular attributes of a record). In conducting searches, a relational database matches information from a field in one table with information in a corresponding field of

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another table to produce a third table that combines requested data from both tables. . . .

Microcomputer database products typically are relational database. *Compare* flat-file database, inverted-list database.” Id.

h. ***Relational Model*** “A data model in which the data is organized in relations (tables). This is the model implemented in most modern database management systems.” Id.

i. ***Table*** “1. In programing, a data structure usually consisting of a list of entries, each entry being identified by a unique key and containing a set of related values. A table is often implemented in an array of records, a linked list, or (in more primitive languages) several arrays of different data types all using a common indexing scheme. 2. In relational databases, a data structure characterized by rows and columns, with data occupying or potentially occupying each cell formed by a row-column intersection. The table is the underlying structure of a relation.”

j. ***Alternative*** “2 a : one of two or more things, courses or propositions to be chosen. Merriam-Webster’s Collegiate Dictionary, 10<sup>th</sup> Edition, Merriam-Webster Inc., Springfield, M.A., 1997.

k. ***Correction*** “3 . . . b : a quantity applied by way of correcting”. Id.

l. ***Designate*** “1: to indicate and set apart for a specific purpose, office or duty” Id.

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**35 U.S.C. 112 6<sup>th</sup> Paragraph**

13. First, after further review of the specification, it is the Examiner's position that the potential means-plus-function limitations in claims 2 and 3 are *not* the *only* point of novelty. The claim is clearly a combination claim since Applicant recites an apparatus. See Paragraph No. 10 *supra*.<sup>9</sup> The Examiner therefore begins his § 112 6<sup>th</sup> paragraph analysis with this presumption. If Applicant disagrees with this presumption, the Examiner respectfully requests Applicant—for each “means for” phrase—to expressly traverse the Examiner's presumption in their next properly filed response and provide appropriate arguments in support thereof. Failure by Applicant to address this issue or to be non-responsive to this issue entirely in their next properly filed response will be considered a desire by Applicant to maintain the presumption that the means-plus-function limitations are not the claims' *only* point of novelty.

**Means Phrase #1*****Invocation***

14. It is the Examiner's position that in claim 6, the phrase “means for storing in a computer system a list of raw materials” (“Means Phrase #1”) is an attempt by Applicants to invoke 35 U.S.C. 112 6<sup>th</sup> paragraph. If Applicants disagree, the Examiner respectfully requests Applicants to either amend the claim to remove all instances of “means for” from the claim, or to explicitly

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<sup>9</sup> See e.g. *Aro Mfg. Co. v. Convertible Top Replacement Co.*, 365 U.S. 336, 345, 128 USPQ 354, 359 (1961) (stating that “there is no legally recognizable or protected ‘essential’ element, ‘gist’ or ‘heart’ of the invention in a combination patent.”)

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state on the record (and supply arguments in support thereof) why 35 U.S.C. 112 6<sup>th</sup> paragraph should not be invoked.

**Invocation Step 1:**

a. First, in accordance with the MPEP §2181, the *Supplemental Examination Guidelines for Determining the Applicability of 35 USC 112 6<sup>th</sup>* (“Guidelines”)<sup>10</sup>, and *Al-Site Corp. v. VSI International Inc.*, 174 F.3d 1308, 1318, 50 USPQ2d 1161, 1166 (Fed. Cir. 1999),<sup>11</sup> Applicant’s use of “means for” in claim 1 creates a rebuttable presumption that tends to invoke 35 U.S.C. 112 6<sup>th</sup> paragraph. If the word “means” appears in a claim element in combination with a function, it is presumed to be a means-plus-function element in which §112 6<sup>th</sup> paragraph applies. *Id.* Since “means for” is recited in Means Phrase #1, this step is clearly met.

**Invocation - Step 2:**

b. Second, in accordance with MPEP §2181, the Guidelines, and *Budde v. Harley-Davidson, Inc.*, 250 F.3d 1369, 1376, 58 USPQ2d 1801, 1806 (Fed. Cir. 2001), it is the Examiner’s position that Applicants recite a corresponding function to the means—“for storing in a computer system a list of raw materials.”

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<sup>10</sup> Federal Register Vol 65, No 120, June 21, 2000.

<sup>11</sup> See also *Sage Prods., Inc. v. Devon Industry, Inc.*, 126 F.3d 1420, 1427, 44 USPQ2d 1103, 1109 (Fed. Cir. 1997); *Greenberg v. Ethicon Endo-Surgery, Inc.*, 91 F.3d 1580, 1583, 39 USPQ2d 1783, 1785 (Fed. Cir. 1996).

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The Examiner notes that when determining the function recited “[u]nless something in the written description suggests that the patentee intended the unambiguous language to be construed in a manner inconsistent with its ordinary meaning, we are bound by that language.” *Telemac Cellular Corp. v. Topp Telecom Inc.*, 58 USPQ2d 1545, 1550 (Fed. Cir. 2001). Here, the function as found in the Means Phrase #1 will have its ordinary meaning.

**Invocation - Step 3:**

c. Third, in accordance with MPEP §2181, the Guidelines, and *Personalized Media Communications, LLC v. International Trade Commission*, 161 F.3d 696, 704, 48 USPQ2d 1880, 1887 (Fed. Cir. 1998), the means-plus-function clause must not recite sufficient definite structure for performing that function.

In our case, Means Phrase #1 does not recite the structural elements which perform the function. In determining whether the presumption of invocation is rebutted, “the focus remains on whether the claim ... recites sufficiently definite structure.” *Id.* Furthermore, sufficient structure does not require an exhaustive recitation—only structure to perform entirely the claimed function. *Rodime PLC v. Seagate Technology Inc.*, 174 F.3d 1294, 1304, 50 USPQ2d 1429, 1436 (Fed. Cir. 1999). Clearly the “storing in a computer system a list of raw materials” can not be entirely performed by the little if any recited structure in the claim.

Because of the above, it is the Examiner’s position that Means Phrase #1 invokes 35 U.S.C. 112 6<sup>th</sup> paragraph.

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*Corresponding Structure, Material, or Acts*

15. In accordance with MPEP §2181, the Guidelines (section “II”) and *Medtronic*, 248 F.3d at 1311, 58 USPQ2d at 1614, “The next step is to determine the corresponding structure described in the specification and equivalents thereof. Structure disclosed in the specification is ‘corresponding’ structure only if the specification or prosecution history clearly links or associates that structure to the function recited in the claim.” *Id.*

a. In our case and as noted above in the section title ‘35 U.S.C. 112 2<sup>nd</sup> Paragraph,’ the corresponding structure is not clearly linked or associated in the written description with the required specificity. Therefore, a 35 U.S.C. 112 2<sup>nd</sup> paragraph rejection results. “If the language of the claim is such that a person of ordinary skill in the art could not interpret the metes and bounds of the claim so as to understand how to avoid infringement, a rejection of the claim under 35 U.S.C. 112, second paragraph would be appropriate.” MPEP §2173.02 citing *Morton Int’l, Inc. v. Cardinal Chem. Co.*, 5 F.3d 1464, 1470, 28 USPQ2d 1190, 1195 (Fed. Cir. 1993). For example, the corresponding structure could be a CPU, hard drive, computer memory, the BIOS, other software, all of the above, or some other structure. Because of this ambiguity, it is the Examiner’s factual determination that a person of ordinary skill in the art could not interpret the metes and bounds of the claim so as to understand how to avoid infringement.

16. The Examiner will next apply the above reasoning to all claimed phrases that potentially invoke 35 U.S.C. 112 6<sup>th</sup> paragraph. Citations and authorities will be omitted for clarity.

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17. It is the Examiner's position that Means Phrase #1 and all subsequent means phrases have considered including the entire specification, including claims and drawings.

**Means Phrase #2**

18. It is the Examiner's position that the "means for populating a plurality of filter lists corresponding with said stored customer application criteria" ("Means for Phrase #2") invokes 35 U.S.C. 112 6<sup>th</sup> paragraph.

- a. Means for Phrase #2 meets Invocation Step 1 because "means for" is recited.
- b. Means for Phrase #2 meets Invocation Step 2 because the phrase recites the function of "for populating a plurality of filter lists corresponding with said stored customer application criteria." This function will have its ordinary and plain meaning.
- c. Means for Phrase #2 meets Invocation Step 3 because the claim does not recite sufficient definite structure for performing the function of "for populating a plurality of filter lists corresponding with said stored customer application criteria . . . ."
- d. The specification fails to directly disclose what structural elements make up Means Phrase #2. In other words, the corresponding structure is not clearly linked or associated in the specification with the required specificity. For prior art purposes only, the Examiner will presume that the corresponding structure is the CPU, software, and memory.

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**Means Phrase #3**

19. It is the Examiner's position that the "means for displaying the entry of the designated sales item data and the entries of correction sales item data on said display device in such a manner that the entry of the sales item data is displayed in a different format from the entries of correction alternative sales item data . . . ." ("Means for Phrase #3") invokes 35 U.S.C. 112 6<sup>th</sup> paragraph.

- a. Means for Phrase #3 meets Invocation Step 1 because "means for" is recited.
- b. Means for Phrase #3 meets Invocation Step 2 because the phrase recites the function of "for populating a plurality of filter lists corresponding with said stored customer application criteria." This function will have its ordinary and plain meaning.
- c. Means for Phrase #3 meets Invocation Step 3 because the claim does not recite sufficient definite structure for performing the function of "for populating a plurality of filter lists corresponding with said stored customer application criteria . . . ."
- d. The specification fails to directly disclose what structural elements make up Means Phrase #3. Again, the corresponding structure is not clearly linked or associated in the specification with the required specificity. For prior art purposes only, the Examiner will presume that the corresponding structure is an ordinary computer monitor.

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*Response to Arguments*

20. Applicant's arguments with respect to the claims in Paper No. 9 have been considered but are moot in view of the new ground(s) of rejection.

21. Applicant's arguments with respect to Rapoport have been fully considered but they are not persuasive. Specifically, Applicant argues that "Rapoport does not distinguish between a designated item in the selected items window from those items in the window that are not designated."<sup>12</sup> The Examiner respectfully disagrees. First, what determines which item is designated is completely up to the user. The claims do not limit the designated item to any particular item. Therefore, the user, selects a designated item from the menu (whatever it is). Clearly the other items in the menu would then be non-designated. Because the non-designated items have a different appearance in reference to the rest of the menu and other items, they have a different format. While the Examiner acknowledges that his interpretation of the claims relies heavily on the broadest reasonable interpretations as noted above, the claims are nevertheless anticipated and/or obvious.

22. Having established that Applicant's claims are system, apparatus, product, or machine claims, it is important to point out that Applicant's claims are replete with conditional expressions. For example, in claim 1, Applicant does not even recite a first operation, only "when a first operation . . . is performed . . . ." The same is true for the second operation, "when a second operation is performed . . . ." "Language that suggest or makes optional but does not

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<sup>12</sup>Applicant's "Remarks", Paper No. 9, page 8, ¶ 2.

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require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. [Emphasis in original.]” MPEP §2106 II C. Clearly the “when” statements create optional characteristics in the claims. The Examiner suggests removing the “when” phrases if Applicants desire to actually claim the first and second modes of operation. Arguments that Applicant’s claims actually *perform* the first and second operations are therefore not persuasive.

23. Applicant is also reminded that “apparatus claims cover what a device is, not what a device does.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). Claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. See *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). In this case, Applicant’s product claims must be distinguished in the form of structure rather than use.

### ***Conclusion***

24. Applicant’s amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

25. Unless expressly noted otherwise by the Examiner, the following two citations to the Manual of Patent Examining Procedure (“MPEP”) apply to this Office Action: MPEP citations to Chapters 200, 700, 1800, and 2100 are from the MPEP 8<sup>th</sup> Edition, Rev 1, February 2003. All remaining MPEP citations within this Office Action are from the MPEP 8<sup>th</sup> Edition, August 2001.

26. Because this application is now final, Applicant is reminded of the USPTO’s after final practice as discussed in MPEP §714.12 and §714.13 and that entry of amendments after final is *not* a matter of right. “The refusal of an examiner to enter an amendment after final rejection of claims is a matter of discretion.” *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed. Cir. 2002) (citations omitted). Furthermore, suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that the claim is “allowed,” exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has *not been addressed* with respect to other aspects of patentability (e.g. §101 patentable subject matter, §112 1<sup>st</sup> paragraph written description and enablement, §112 2<sup>nd</sup> paragraph antecedent basis and indefiniteness, and §102 and §103 prior art).

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Therefore, any claim amendment submitted under 37 C.F.R. §1.116 that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as described above.

27. In accordance with *In re Lee*, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), the Examiner cites How Computers Work Millennium Ed. by Ron White; How Networks Work, Millennium Ed. by Frank J. Derfler et. al.; and How the Internet Works, Millennium Ed. by Preston Gralla as additional evidence of what is basic knowledge or common sense to one of ordinary skill in this art. Each reference is cited in its entirety. Since the references are directed towards beginners, the references are primarily directed towards those of *low* skill in the art. Therefore, one of *ordinary* skill in the art must—at the very least—be aware of the knowledge contained within the references. The Examiner has provided Applicant with copies of selected sections including the table of contents, indexes, and/or Parts of the references.

28. In accordance with the USPTO's goals of customer service, compact prosecution, and reduction of cycle time, the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has again provided Applicant with notice—for due process purposes—of his position regarding his factual determinations and legal conclusions. The Examiner notes and thanks Applicant for their "Remarks" (Paper No. 9, beginning on page 6) traversing the Examiner's positions on various points. If Applicant disagrees with any additional factual determination or legal conclusion made

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by the Examiner in this Office Action whether expressly stated or implied<sup>13</sup>, the Examiner respectfully reminds Applicant to properly traverse the Examiner's position(s) in accordance with 37 C.F.R. §1.111(b) *in their next properly filed response*. By addressing these issues now, matters where the Examiner and Applicant agree can be eliminated allowing the Examiner and Applicant to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time. If Applicant has *any* questions regarding the Examiner's positions or has other questions regarding this communication or even previous communications, Applicant is strongly encouraged to contact Examiner Andrew J. Fischer whose telephone number is (703) 305-0292.

*AJF 6/3/03*  
**ANDREW J. FISCHER**  
**PATENT EXAMINER**

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AJF  
June 3, 2003

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<sup>13</sup> E.g., if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner's implied position that the references are analogous art.